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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,835	01/31/2005	Anne Hupp	PAT-01087	6570
26922	7590	11/21/2006	EXAMINER	
BASF CORPORATION 1609 BIDDLE AVENUE WYANDOTTE, MI 48192			ABU-ALI, SHUANGYI	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 11/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/522,835

Applicant(s)

HUPP ET AL.

Examiner

Shuangyi Abu-Ali

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>31/01/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

(1)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 1- 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,093,497 to Wiemann et al., in view of CA 2,154,818 to Stefan et al.

Regarding claims 1 – 2 and 7-8, Wiemann et al. disclose an aqueous basecoat composition, wherein the pigment (such as metallic aluminum and aluminum alloy pigments) amount is preferred in a range of 5-25%(col. 4 lines 42-48; col. 4, lines 60-62), and the amount of the thickener is preferable in the range of 0.3-1.5%(col. 3, lines 39-41). The thickener of basecoat composition is acrylate copolymers with non-associative groups. The acrylate copolymer is made from at least two different (C1 –C6) alkyl methacrylate monomers and (meth) acrylic acid (col. 3, lines 11-18). The amount of the amine in the composition is around 0.4% (col. 12, line 63).

Although Wiemann et al. disclose aqueous coating composition, they are silent as to the specific amount of water and surfactant in basecoat composition as applicant claimed in claim 1.

Stefan et al., however, also drawn to aqueous coating composition disclose an aqueous pigment composition in their invention, which has an amount of 40-60% metal oxide pigment, 0-2% of thickener, 0.1-4.9% of an amine, 0.1-0.9% of nonionic surfactant and 21.3-57.8% of water (abstract).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to use the surfactant of Stefan et al. in the basecoat composition of Wiemann et al. to make an aqueous pigment paste as applicant claimed in claim 1, motivated by the fact that Stefan et al. disclose that the use of

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such surfactant additives provide the aqueous pigment composition with good stability and durability (page 5, lines 4-5; page 8).

Regarding claim 3, Wiemann et al. disclose that the thickener of acrylate polymer has an amount of 40-60% (meth) acrylic acid (col. 3, lines 18-20).

Regarding claims 4-6, Wiemann et al. disclose that dimethylethanolamine is used to adjust PH in the coating mixture (col. 12, line 4).

Regarding claim 9, Wiemann et al. disclose a basecoat composition, which is compatible with a pigment such as aluminum bronzes (col. 4, lines 38-41). And basecoat composition comprises an amount of 25-50% inorganic color imparting pigment (col. 5, line 9). The amount of thickener, made from C₁ – C₆ alkyl (meth) acrylate and methacrylic acid, is in the range of 0.5-5% (col.3, line 41 and col. 1, lines 60-62). But they are silent as to the specific amount of water, amine and surfactant in basecoat composition as claimed by applicant in claim 9.

Stefan et al., however, also drawn to aqueous coating composition disclose an aqueous pigment composition in their invention, which has an amount of 0.1-4.9% of an amine, 0.1-0.9% of nonionic surfactant and 21.3-57.8% of water (abstract).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to use the surfactant of Stefan et al. in the basecoat composition of Wiemann et al. to make an aqueous pigment paste as claimed by applicant in claim 1, motivated by the fact that Stefan et al. disclose that the use of such surfactant additives provide the aqueous pigment composition with good stability and durability (page 5, lines 4-5; page 8).

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Regarding claims 10-11, Wiemann et al. disclose a method of adding effect pigment into the aqueous basecoat composition (col. 4, lines 62 - 64; col. 12, lines 9-10).

Regarding claim 12, Wiemann et al. disclose a method to apply an aqueous basecoat composition, an optional transparent topcoat to a substrate (col. 1, lines 4-11).

Regarding claim 13, Wiemann et al. describe a process of preparing an aluminum pigment in the amount of 5-15%, auxiliary binder, water and surfactant in a slurry state (col. 4, line 60 – col. 5, line 5) for the basecoat composition. The basecoat composition has 0.5-15% thickener made from C₁ – C₆ alkyl (meth)acrylate and methacrylic acid (col.3, line 41 and col. 1, lines 60-62).

Although Wiemann et al. disclose using surfactant in basecoat, they are silent about the specific amount used as claimed by applicant in claim 13.

Stefan et al., however, also drawn to aqueous coating composition disclose an aqueous pigment composition has an amount of 0.1- 0.9 % nonionic surfactant (abstract).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to use the surfactant of Stefan et al. in the process of preparing basecoat composition of Wiemann et al. as claimed by applicant in claim 13, motivated by the fact that Stefan et al. disclose that the use of such surfactant additives provide the aqueous pigment composition with good stability and durability (page 5, lines 4-5; page 8).

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Regarding claims 14 and 15, Wiemann et al. disclose water-soluble resin such as amino resin, polyester and polyurethanes used as binders in the process of preparing basecoat composition (col. 4, lines 4-10).

(2)

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Such prior art is listed on PTO-892 A-E, G-H and N.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shuangyi Abu-Ali whose telephone number is 571-272-6453. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service

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Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SA


J. A. LORENZO
SUPERVISORY PATENT EXAMINER